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DOUGHERTY & TROXELL
SUITE 1404
5205 LEESBURG PIKE
FALLS CHURCH, VA 22041

EXAMINER

HYLTON, ROBIN ANNETTE

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3727

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/924,471
Filing Date: August 09, 2001
Appellant(s): DAVIDOV ET AL.

MAILED

MAR 24 2006

Group 3700

Bruce H. Troxell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 21, 2005 appealing from the Office action mailed February 23, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

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(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

DE 200 00 079	Heidorn	5-2000
WO 95/07847	Schoenmakers	3-1995
US 6,371,324	Torniainen et al.	4-2002
US 3,955,742	Marshall et al.	5-1976

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1,2,4,7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidorn (DE 200 00 079) in view of Schoenmakers (WO 95/07847).

Heidorn teaches a lid comprising a) a top cover wall having a generally planar configuration, the top cover wall having outer periphery, a side wall extending downwardly from the periphery of the top cover wall and configured to engage the rim of the food container, the side wall including first and second wall portions wherein the second wall portion of one lid is configured to accept therein the first wall portion of another lid so as to enable a plurality of lids to be stacked in nested fashion and an eating utensil located in openings of the top cover wall, the utensil having a food engaging portion of "substantially" uniform thickness and an integral handle portion extending therefrom, the handle portion being configured to be gripped by a hand of a user, the one-piece eating utensil being removably connected to the top cover wall solely by a plurality of discrete, spaced apart, frangible connecting elements, a length of the one-piece eating utensil from an end of the food engaging portion to an end of the handle portion being less than a distance between opposite sides of the periphery of the top cover wall. The English translation provided by applicant specifies on page 1 of the specification and in claim 1 that the spoon is made in one piece with the lid, just as that of the instant invention is formed as one piece. Thus, the spoon inherently has a "substantially uniform thickness".

Heidorn does not teach a one-piece eating utensil within a single opening through the lid cover wall, it would have been obvious to one of ordinary skill in the art at the time the invention was made to eliminate the secondary handle extension **2** and form a one-piece eating utensil as taught by Schoenmakers. Doing so would have been an obvious matter of design choice to save on manufacturing costs, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. In the instant case, forming the eating utensil of Heidorn in one-piece saves manufacturing costs in terms of time and labor.

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Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of Torniainen et al. (US 6,371,324).

Heidorn as modified by Schoenmakers teaches the claimed lid except the eating utensil being a fork or a knife.

Torniainen teaches a lid having a detachable eating utensil wherein the utensil can be a spoon as seen in figure 1 or can be a fork, spork, or knife as described in column 5, lines 40-42 and column 13, lines 7-10.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teaching of a fork and a knife as an eating utensil removably attached in the opening of the lid of Heidorn. Doing so provides alternative utensils as appropriate for the food contained within the associated container.

Claims 1,2,4,7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidorn in view of Schoenmakers.

Heidorn teaches a lid comprising a) a top cover wall having a generally planar configuration, the top cover wall having outer periphery, a side wall extending downwardly from the periphery of the top cover wall and configured to engage the rim of the food container, the side wall including first and second wall portions wherein the second wall portion of one lid is configured to accept therein the first wall portion of another lid so as to enable a plurality of lids to be stacked in nested fashion and an eating utensil located in openings of the top cover wall, the utensil having a food engaging portion of "substantially" uniform thickness and an integral handle portion extending therefrom, the handle portion being configured to be gripped by a hand of a user, the one-piece eating utensil being removably connected to the top cover wall solely by a plurality of discrete, spaced apart, frangible connecting elements, a length of the one-piece

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eating utensil from an end of the food engaging portion to an end of the handle portion being less than a distance between opposite sides of the periphery of the top cover wall. The English translation provided by applicant specifies on page 1 of the specification and in claim 1 that the spoon is made in one piece with the lid, just as that of the instant invention is formed as one piece. Thus, the spoon of Heidorn must inherently have a substantially uniform thickness.

Wherein it can be argued the food engaging portion of Heidorn is not of "substantially uniform thickness", it would have been obvious to one of ordinary skill in the art at the time the invention was made to manufacture the spoon of a "substantially uniform thickness". Doing so would eliminate the need for a more expensive mold having different thicknesses.

Heidorn does not teach a one-piece eating utensil within a single opening through the lid cover wall, it would have been obvious to one of ordinary skill in the art at the time the invention was made to eliminate the secondary handle extension 2 and form a one-piece eating utensil as taught by Schoenmakers. Doing so would have been an obvious matter of design choice to save on manufacturing costs, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. In the instant case, forming the eating utensil of Heidorn in one-piece saves manufacturing costs in terms of time and labor.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of Torniainen.

Heidorn as modified by Schoenmakers teaches the claimed lid except the eating utensil being a fork or a knife.

Torniainen teaches a lid having a detachable eating utensil wherein the utensil can be a spoon as seen in figure 1 or can be a fork, spork, or knife as described in column 5, lines 40-42 and column 13, lines 7-10.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teaching of a fork and a knife as an eating utensil removably attached in the opening of the lid of Heidorn. Doing so provides alternative utensils as appropriate for the food contained within the associated container.

(10) Response to Argument

Appellant argues the combination of Heidorn and Schoenmakers does not render the claims obvious.

First, appellant argues the lid of Heidorn does not teach the "first and second wall portions wherein the second wall portion of one lid is configured to accept therein the first wall portion of another lid so as to enable a plurality of lids to be stacked in nested fashion". The claims do not specify structure which allows the lid to be so configured. It is submitted that 1) a lid having a smaller diameter can be received within the lid of Heidorn to allow nesting of a plurality of lids, and 2) the lid structure of Heidorn, i.e., a first skirt and a second skirt, allows for nesting of a plurality of lids as evidenced by Torniainen et al. (column 2, lines 37-41). Either of these explanation allow for the lid of Heidorn to be inherently capable of allowing for stacking in nested fashion a plurality of lids.

Secondly, appellant argues the patent to Heidorn does not explicitly teach the utensil has "a food engaging portion of substantially uniform thickness". As set forth in the "Response to Arguments" section of the final rejection mailed February 2, 2005, the instant specification does not provide that "substantially uniform thickness" is more specific than manufacturing tolerance.

Moreover, it is pointed out that the instant specification is silent regarding the food-engaging portion being of "substantially uniform thickness". The drawings *appear* to show this feature (thus no matter rejection was raised by the examiner). Since the specification of the instant application does not specifically teach the food engaging portion of the spoon is of a "substantially uniform thickness", it is reasoned that this feature is inherent in the manufacture of a one-piece lid and eating utensil. Inherency does not require a specific teaching since it is based upon a well-established and known characteristic or trait. See, for instance, Marshall et al. (US 3,955,742) which teaches an integrally molded lid and spoon, the spoon's food engaging portion being of "substantially uniform thickness". See figure 1.

Lastly, wherein portion **2** of the utensil of Heidorn is similar in configuration to the utensil shown in figure 8 of the instant application, it is a one-piece eating utensil. Portion **2** of Heidorn is clearly seen to be of uniform thickness except at the notched, gripping end which would be grasped for holding the utensil during use.

Regarding the combination of Heidorn and Schoenmakers as set forth by the examiner, appellant has proceeded to change the rejection through his arguments. Heidorn is set forth as teaching the claimed limitations except for a "single" opening in the cover top wall. Schoenmakers provides the teaching of a single opening in a cover top wall and an eating utensil located in the single opening in the cover top wall. The thickness of Schoenmakers's eating utensil is not at issue.

The rejection does not "arbitrarily pick and choose" the patent limitations to form the rejections as asserted by appellant. Appellant's amendment to the claim(s) required a single opening. The examiner provided a teaching of a single opening in a cover top wall having an eating utensil therein for the state of the art at the time of appellant's invention. Additionally, case law, i.e., *In re Karlson*, 136 USPQ 184 (i.e., "omission of an element and its function in a

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combination where the remaining elements perform the same functions as before involves only routine skill in the art"), was also cited in combination with the prior art rejection. This case law citation could also have been applied in the rejection without the teaching of Schoenmakers, but was not. Although the teachings of the patents would have been sufficient, the case law citation was applied as further evidence of the obviousness of the instant claims.

Regarding the teaching of Torniainen et al. as set forth in the rejections, appellant has offered that the teaching does not provide other features appellant asserts are not taught in the base rejection utilizing Heidorn and Schoenmakers. Since the patent to Torniainen as applied only for its teaching of different kinds of eating utensils, it was not intended to provide any other teaching. Thus, claims 5 and 6 rejected thereby does not require other rejections.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Robin Hylton

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Primary Examiner GAU 3727